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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,436	05/17/1999	DAVID S. SPRINGER	M-7260US	3911
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SKJERVEN MORRILL LLP 25 METRO DRIVE SUITE 700 SAN JOSE, CA 95110			EXAMINER	
			LE, KHANH H	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 06/24/2002				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/313,436 Examiner Khanh H. Le	SPRINGER ET AL. Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 3/18/02 KHL
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10, 12-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10, 12-20 and 22-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Final Action

1. This Office Action is responsive to Applicant's Correspondence filed March 6 , 2002 (paper # 5).
2. Amendment of Claims 1, 7, 10 and 17 have been entered. Claims 11 and 21 have been canceled. Claims **1-10, 12-20, 22-24** are pending in the application.

3. Response to Arguments

In view of the amendments , new grounds of rejection, slightly modified from the previous grounds, are presented below.

Claim 1.

Newly amended claim 1 incorporates some limitations of the original claim 7.

Claim 7 had been rejected under 35 U.S.C. 103 under Reilly, US 5740549 in view of the Official Notice that the steps of claim 7 , which amount to registration of a new computer user, are well known.

Applicants traverse the Official Notice. In response, some references are provided in support of the previously taken Official Notice. Applicants are referred to the rejection of Claim 1 under 35 U.S.C. 103 below.

Claim 5.

The application program of claim 5

“...an application program, the application program querying the computer user as to information specific to the computer user;

if the computer system does not contain a preexisting identifier associated with the at least one database, querying the computer user as to information specific to the computer user; and storing the information in one of the at least one database”

essentially serves to implement the following steps of Claim 1:

“when the server receives an identifier, checking the at least one database for the identifier;

if the identifier is not found, querying the computer user as to whether the computer user desires to participate in receiving the information from the server;

if the computer user desires to participate, building one of the at least one databases that associates the identifier with the computer user”.

and thus claim 5 is rejected on the same basis as those limitations of claim 1.

Claim rejections USC 112.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and
distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being unclear
because the essential steps are out of order, such reversal of steps amounting to a gap between
the steps. See MPEP § 2172.01.

The reversed steps are as follows : the steps of transmitting the information and of
logging the transmittal should follow the new user initiation steps to be logical.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be
found in a prior Office action.

7. **Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Reilly et al., US 5740549 in view of other well-known business and computer methods.**

Claim 1.

Reilly discloses

A method of tracking information provided to a computer system from
a server, the method comprising:

providing an identifier identifying the computer system (Fig 4 and associated text especially
item 212, 213);

providing at least one database associating the identifier with information specific to a computer
user associated with the computer system (Fig 4 and associated text, especially items 216, 214);

transmitting the identifier to the server, the server affiliated with the at least one database (Figs
11 and 12 and associated text; col 14 l. 17 –col 16 l. 35; Fig 4 and associated text especially
items 212, 213);

Reilly does not specifically disclose the following steps:

*"when the server receives an identifier, checking the at least one database for the identifier;
if the identifier is not found, querying the computer user as to whether the computer user desires to participate in receiving the information from the server;
if the computer user desires to participate, building one of the at least one databases that associates the identifier with the computer user"*

which amount generally to steps for registration of a new computer user, which steps are well known prior to alleged invention time.

For example,

Eggleson et al, US 6061660, discloses the process of registration of any user, (Figs. 8, 9, 13 and associated text) which typically consists of the following exemplary steps :
"If the consumer is not found in the consumer database 200 at the step 309, then the consumer is prompted to respond whether the consumer wishes to register as a member of the host system at a step 306. If the consumer wishes to register at the step 306, then the consumer is prepared to complete a registration process at the step 306. If at the step 306 the consumer declines to register, then the consumer is returned at a step 320 to a message informing the consumer that the host system's capabilities require registration and that the consumer may log out by using the back key of the consumer's browser. "

Goldhaber et al., US 5794210, discloses the sign-up process of new users in Fig 12 and associated text,col 17 .

Angles et al., US 5933811 discloses registration of new users (Figs 2, 4, 5, 6, 7, and respective associated text; also see cols. 3, 4, 8, 10, 11, 12, 13-14, 15, 16) .

One skilled in the arts would have found it obvious to incorporate the known (yet now claimed) steps of new user initiation into the Reilly's system, as they are logical steps to implement the Reilly's disclosure of identifying the user, the user ' s system and the user's profile for later customized delivery of news and other information system. The combination is obvious is also obvious as all the above references all address advertising/marketing issues.

As to the rest of Claim 1 limitations, Reilly discloses:

transmitting the information to the computer system that is specific to the identifier (Figs 11 and 12 and associated text; col 14 l. 17 –col 16 l. 35; Fig 4 and associated text especially items 212, 213;);

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and logging the transmittal of the identifier in one of the at least one database. (Fig 2 and associated text especially item 210; Fig 4 and associated text especially item 218) . (Further, see generally Wexler, US 5960409; Graber et al., US 5712979 for tracking techniques)

Claims 10 and 17 essentially parallel claim 1 in computer system and system formats respectively and are rejected on the same basis.

As for claims 2-9, the method of claim 1 is disclosed as above-discussed.

As for claims 11-16, the method of claim 10 is disclosed as above-discussed.

As for claims 18-24, the method of claim 17 is disclosed as above-discussed.

Claim 2. The method of Claim 1 wherein the logging the transmitting of the identifier further includes: incrementing a counter associated with the identifier. (Fig 2 and associated text especially item 210; Fig 4 and associated text especially item 218);

Claims 14 and 18 essentially parallel claim 2 in computer system and system formats respectively and are rejected on the same basis.

Claim 3. The method of Claim 1 further comprising:

providing that the information transmitted to the computer system includes at least one of advertisements, informational data, advertisements specific to the computer user, and informational data specific to the computer user.

(Figs 11 and 12 and associated text;)

Claim 19 essentially parallel claim 3 in system format and is rejected on the same basis.

Claim 4. Reilly further providing that the server is a server hosting advertisements and informational data. (Figs 11 and 12 and associated text;)

Claim 20 essentially parallels claim 4 in system format and is rejected on the same basis.

Claim 6. The method of Claim 1 wherein the transmitting the identifier includes: requesting access to the server by the computer user via the worldwide web; and transmitting the identifier when the computer user requests access from the server.

Fig 1 and 2 and associated text)

Claims 12 and 22 essentially parallel claim 6 in computer system and system formats respectively and are rejected on the same basis.

Claim 8.

The method of Claim 1 wherein the identifier is one of a system code, system code stored in nonvolatile memory, a unique ID from a microprocessor, a user ID from a peripheral device and a unique identifier stored on a hard drive.

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It is well-known that the identifier can be one of those above claimed. One skilled in the arts would have known to use one of those to apply to the Reilly's system to implement it.

Claims 16 and 24 essentially parallel claim 8 in computer system and system formats respectively and are rejected on the same basis.

Claim 5.

The method of Claim 1 further comprising:

providing an application program, the application program querying the computer user as to information specific to the computer user;

if the computer system does not contain a preexisting identifier associated with the at least one database, querying the computer user as to information specific to the computer user; and storing the information in one of the at least one database.

Reilly does not explicitly discloses such application program but the application program of claim 5

"... an application program, the application program querying the computer user as to information specific to the computer user;

if the computer system does not contain a preexisting identifier associated with the at least one database, querying the computer user as to information specific to the computer user; and storing the information in one of the at least one database"

essentially serves to implement the following steps of Claim 1:

"*when the server receives an identifier, checking the at least one database for the identifier;*

if the identifier is not found, querying the computer user as to whether the computer user desires to participate in receiving the information from the server;

if the computer user desires to participate, building one of the at least one databases that associates the identifier with the computer user".

and thus claim 5 is rejected on the same basis as those limitations of claim 1.

One skilled in the arts would have known to use the above-claimed steps as they are logical steps to implement the Reilly's disclosure of identifying the user, the user ' s system and the user's profile for customized delivery of news and other information system.

Claims 11 and 21 essentially parallel claim 5 in computer system and system formats respectively and are rejected on the same basis.

Amended Claim 7.

The method of Claim 1 further comprising:

if the identifier is found in the at least one database, searching for matching information unique for the identifier and for the computer user; if matching information is found, transmitting

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the information unique for the identifier and for the computer user to the computer user from the server;

if no matching information is found, transmitting one of generic information and no information;

and logging the transmittal of the identifier in one of the at least one database.
(see Reilly, Fig 11s and 12 and associated text; also see rejection of claim 1 above for the "matching" and "logging of transmittal "limitations).

Claim 9.

The method of Claim 1 wherein the information unique to the computer user includes one of incentives, bonuses and discounts on a plurality of goods.

Reilly does not specifically disclose such but they are usually well-known parts of advertisements (disclosed by Reilly , Fig 1, item 138 and associated text) thus one skilled in the arts would have known to combine them with Reilly's disclosure to provide customized incentives,(also , e.g., in affinity schemes) which are a well-known business methods.

Claims 13 and 23 .

Claims 13 and 23 essentially parallel claim 9 (also claim 3) in computer system and system formats respectively and are rejected on the same basis. (Claims 13 and 20 recite " at least one of advertisements, informational data, advertisements specific to the computer user, and informational data specific to the computer user").

Claim 15.

The computer system of Claim 10 wherein the database is affiliated with an advertisement broker that is also affiliated with the server, the advertisement broker receiving the identifier and logging the transmittal of the identifier in a database to track the transmittal of information specific to the computer user.

Reilly does not specifically disclose an advertisement broker that is also affiliated with the server however such ads brokers/server affiliation is well-known in the arts (se e.g. Dedrich, US 5752238). One skilled in the arts would have known to combine the Reilly's and Dedrich disclosures to extend the reach of the Reilly's system to third parties advertising systems.

Conclusion

8. Prior art made of record (see all cited above) and not relied upon is considered pertinent to applicant's disclosure.

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is (703) 305-0571. The examiner is on flexible schedule and can normally be reached on Tuesday-Thursday from 9:00 AM - 6:30 PM. The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469.

The Official Fax Numbers for TC-2100 are:

After-final	(703) 746-7238
Official	(703) 746-7239
Non-Official/Draft	(703) 746-7240

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

June 13, 2002

KHL
K.H. Le


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